

REMARKS

This is intended as a full and complete response to the Office Action dated December 16, 2004, having a shortened statutory period for response set to expire on March 16, 2005.

Claims 1-5, 8-21, 56-61, and 63-77 remain pending in the application and are shown above. Claim 62 has been cancelled, and claims 70-77 have been added. Claims 2, 9-11, 13-18, and 65 are objected to, and claims 56-64 and 66-68 are indicated to be allowable by the Examiner. Reconsideration of the rejected or objected claims is requested for reasons presented herein.

Claims 1, 3-5 and 12 stand rejected under 35 U.S.C. § 102(b) as being clearly anticipated by *Diefendorf*. In reply to Applicant's previously filed response, the Examiner states that the new limitation was "still very broad as all wrenches have an opening that is at an edge that will lead into the engagement passage."

Applicant respectfully traverses this rejection. Anticipation requires that each and every element of the claimed invention be disclosed in a single prior art reference. In re Paulsen, 30 F.3d 1475 (Fed. Cir. 1994). In response to the Examiner's argument, not all wrenches have an opening at an edge. For example, a box end wrench is a wrench that does not have an opening at an edge. *Diefendorf* discloses a two piece clamp (2,3) connected around a pipe by bolts. *Diefendorf* does not teach, show, or suggest an opening provided from an edge to the axial passage, as recited in claim 1. Because *Diefendorf* fails to disclose at least one element of claim 1, withdrawal of the rejection is respectfully requested.

With respect to claim 72, *Diefendorf* does not teach, show, or suggest a drive mechanism attached to the first gripping apparatus and engaged with the second gripping apparatus, wherein actuation of the drive mechanism causes the first gripping apparatus to rotate relative to the second gripping apparatus

Claims 8, 19-21 and 69 stand rejected under 35 USC § 103 (a) as being unpatentable over *Diefendorf*, in view of *Smith* or *Jurgens*.

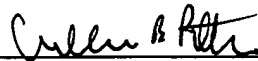
Applicant respectfully traverses this rejection. *Diefendorf*'s pipe screwing device is used for securing pipes in trenches. The device has a handwheel that extends out of the trench for turning the clamp. One of the advantages of the device is that it "gives sufficient power to set up the pipe with little effort on the part of the workman and the rod being extended above the trench makes the operation of the device possible in a convenient position." Because the *Diefendorf* device is designed to be easily assembled in the trench and easily moved from pipe to pipe, it would not have been obvious to add a motor to the handwheel of *Diefendorf*.

Moreover, both *Smith* and *Jurgens* teach a motor attached to the same tong that the motor is rotating. However, *Diefendorf* teaches attaching the pinion to the non-rotating tong. Therefore, it would not have been obvious to combine the motor of either *Smith* or *Jurgens* with the pipe screwing device of *Diefendorf*. The Federal Circuit has held that it is impermissible within the framework of § 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. Bausch & Lomb, Inc. v. Barnes-Hind, Inc., 796 F.2d 443, 230 U.S.P.Q. 416 (Fed. Cir. 1986). The references, neither alone nor in combination, teach, show, or suggest a motor coupled to the at least one pinion; a first clamping member for clamping the first tubular within the gear, the at least one pinion being attached to a second clamping member for clamping the second tubular, and the at least one pinion meshing with the gear in such a way that the first clamping member and the second clamping member can be rotated relative to one another by rotating the at least one pinion, as recited in claim 19. Additionally, the references, neither alone nor in combination, teach, show, or suggest one of the clamping members being supported by a frame for handling at an oil rig, as recited in claim 69. Withdrawal of the rejection is respectfully requested.

In conclusion, the references cited by the Examiner, alone or in combination, do not teach, show, or suggest the invention as claimed.

Having addressed all issues set out in the office action, Applicant respectfully submits that the claims are in condition for allowance and respectfully requests that the claims be allowed.

Respectfully submitted,



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